

Serial No.: 09/690,367
Response to Office Action

Docket No. 1005.9
Customer No. 53953

REMARKS

Applicant respectfully requests reconsideration of this application in view of the following remarks. Claims 11, 23 and 35 have been amended. Claims 8-12, 20-24 and 32-48 are pending. Antecedent basis for the amendments is located throughout Applicant's specification and the original claims, as for example in connection with the discussion of Figs. 1, 3b, 3l-3q, 4, 6 and 7a-7d. No new matter has been entered.

The Office Action rejected claims 11, 23 and 35 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,763,496 ("Hennings"), in view of U.S. Patent No. 6,486,895 ("Robertson").

As amended, claim 11 recites:

11. A method performed by a computer system, comprising:
storing a first version of a paper, the first version including first content at a first location within the paper;
translating the first version into a second version of the paper, the second version being displayable on a display device as a likeness of the paper, the second version including the first content at the first location within the paper;
in response to the first content at the first location within the paper, detecting a reference within the first content at the first location within the paper, the detected reference being associated with a second location and being at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
in response to the detected reference, forming a link within the second version between the first location and the second location, the link being embedded within at least a portion of the first content at the first location within the paper, and the portion of the first content at the first location within the paper being: displayable on the display device as part of at least the second version, which is displayable on the display device as the likeness of the paper; and user-selectable through the link to cause an operation associated with the second location.

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As amended, claim 23 recites:

23. A system, comprising:
a computing device for:
storing a first version of a paper, the first version including first content at a first location within the paper;
translating the first version into a second version of the paper, the second version being displayable on a display device as a likeness of the paper, the second version including the first content at the first location within the paper;
in response to the first content at the first location within the paper, detecting a reference within the first content at the first location within the paper, the detected reference being associated with a second location and being at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
in response to the detected reference, forming a link within the second version between the first location and the second location, the link being embedded within at least a portion of the first content at the first location within the paper, and the portion of the first content at the first location within the paper being: displayable on the display device as part of at least the second version, which is displayable on the display device as the likeness of the paper; and user-selectable through the link to cause an operation associated with the second location.

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As amended, claim 35 recites:

35. A computer program product, comprising:
a computer program processable by a computer system for causing the computer system to:

- store a first version of a paper, the first version including first content at a first location within the paper;
- translate the first version into a second version of the paper, the second version being displayable on a display device as a likeness of the paper, the second version including the first content at the first location within the paper;
- in response to the first content at the first location within the paper, detect a reference within the first content at the first location within the paper, the detected reference being associated with a second location and being at least one of the following, other than a computer network address: an alphanumeric character; a symbol; a term; and a phrase; and
- in response to the detected reference, form a link within the second version between the first location and the second location, the link being embedded within at least a portion of the first content at the first location within the paper, and the portion of the first content at the first location within the paper being: displayable on the display device as part of at least the second version, which is displayable on the display device as the likeness of the paper; and user-selectable through the link to cause an operation associated with the second location; and

an apparatus from which the computer program is accessible by the computer system.

As stated in MPEP § 2142, "...The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness..." Also, MPEP § 2142 states: "...the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made...The examiner must put aside knowledge of the applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'" Further, MPEP § 2143.01 states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

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In relation to amended claim 11, Hennings and Robertson are defective in establishing a prima facie case of obviousness. For example, as between Hennings, Robertson and Applicant's specification, only Applicant's specification teaches the combination of elements in amended claim 11. In fact, Hennings and Robertson teach away from such a combination.

In citing Hennings, the Office Action acknowledges that "The reference fails to explicitly state the link being embedded within the first location." Nevertheless, the Office Action cites Robertson as teaching the link being embedded within the first location. For example, the Office Action cites Robertson's col. 8, lines 31-49, which states that the data structure for Robertson's "page object" includes "information about selectable regions (links)."

Robertson's "page object" is generated in accordance with Robertson's FIG. 2. Robertson states (at col. 5, lines 39-44):

"Referring to FIG. 2, the *first* step is to generate or otherwise obtain a list of Web Pages, step 201. This can be accomplished in various ways. One way is to analyze a page, such as a home page, and follow and download all the relative *links* on the home page. This is repeated for each subsequent page" (emphasis added).

Further, Robertson states (at col. 5, line 50):

"*Next*, page objects for each web page are generated, step 202" (emphasis added).

Therefore, *after* detecting "*links*," Robertson generates a "*page object*," which "is the internal representation of a web page for use in the book metaphor" (col. 5, lines 51-52).

At col. 3, lines 56-59, Robertson defines "*Link*" as being: "An indicator on a Web page which *refers to another Web page* and which can typically be retrieved in a point and click fashion. The Link will specify the *URL* of the *other Web page*" (emphasis added). At col. 3, lines 52-53, Robertson defines "*URL*" as being: "The *address* or identifier for a page on the *Web*" (emphasis added). At col. 3, lines 43-43, Robertson defines "*Web*" as being: "The portion of the *Internet* that is used to store and access linked multi-media documents" (emphasis added).

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In summary, according to Robertson's own example, it: (a) *first*, detects a "*link*," which specifies the *address* of another page on the *Internet*; and (b) *next*, generates a "*page object*," which is the internal representation of a web page for use in the book metaphor. Consequently, Robertson teaches away from the combination of elements in amended claim 11, which recites (in part):

"in response to the first content at the first location within the paper, detecting a reference within the first content at the first location within the paper, *the detected reference* being associated with a second location and *being at least one of the following, other than a computer network address*: an alphanumeric character; a symbol; a term; and a phrase; and

"in response to the detected reference, forming a link within the second version between the first location and the second location, the link being embedded within at least a portion of the first content at the first location within the paper, and the portion of the first content at the first location within the paper being: displayable on the display device as part of at least the second version, which is displayable on the display device as the likeness of the paper; and user-selectable through the link to cause an operation associated with the second location."

Clearly, therefore, Hennings and Robertson fail to teach amended claim 11, and in fact teach away from it. Thus, the motivation for advantageously combining the claimed elements would arise solely from hindsight based on Applicant's teachings in its own specification. Accordingly, the PTO's burden of factually supporting a prima facie case of obviousness has not been met.

In relation to amended claims 23 and 35, Hennings and Robertson are likewise defective in establishing a prima facie case of obviousness.

Thus, a rejection of amended claims 11, 23 and 35 is not supported.

Conclusion

For these reasons, and for other reasons clearly apparent, Applicant respectfully requests allowance of claims 11, 23 and 35.

Dependent claims 8-10, 12 and 37-40 depend from and further limit claim 11 and therefore are allowable.

Dependent claims 20-22, 24 and 41-44 depend from and further limit claim 23 and therefore are allowable.

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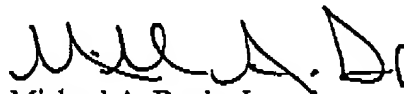
Dependent claims 32-34, 36 and 45-48 depend from and further limit claim 35 and therefore are allowable.

An early formal notice of allowance of claims 8-12, 20-24 and 32-48 is requested.

To the extent that this Response to Office Action results in additional fees, the Commissioner is authorized to charge deposit account no. 50-3524.

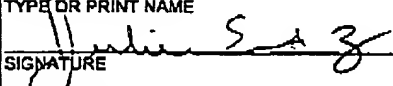
Applicant has made an earnest attempt to place this case in condition for allowance. If any unresolved aspect remains, the Examiner is invited to call Applicant's attorney at the telephone number listed below.

Respectfully submitted,



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